

REMARKSRequest for Reconsideration

Applicants have carefully considered the matters raised by the Examiner in the outstanding Office Action but remain of the position that patentable subject matter is present. Applicants respectfully request reconsideration of the Examiner's position based on the above amendments, the enclosed Declaration and the following remarks.

Claims Status

Claims 2-9 and 15-17 are pending in this Application. Claim 18 has been canceled herein and Claim 15 has been amended.

Specifically, Claim 15 has been amended herein to specify that the light insensitive organic silver salt grains are made from an aliphatic carboxylic acid having 10 to 30 carbon atoms. Support for this amendment can be found on page 42, lines 6-7.

~~Claim 15 has also been amended herein to recite the molar ratio between the compound represented by formula (3) to the compound represented by formula (1). Support for this amendment can be found in original Claim 14 and previously presented Claim~~

18. It will be noted that there is a typographical error in those claims in that they reversed formula (1) and formula (3). This was an obvious typographical error given the fact that Table 1, the molar ratio of formula (3) to formula (1) is clearly shown as falling within the range of 0005 to 0.40. Obviously, if Claim 14 is correct, these molar ratios would not be fractions of 1 but, rather, in the thousands. Thus, it is respectfully submitted that this is an obvious typographical error.

Because of the incorporation of the limitations of Claim 18 into Claim 15, Claim 18 has been canceled herein.

By way of these amendments, it is respectfully submitted that no new matter has been added herein.

Specification Amendments

The Specification has been amended herein to specifically recite the limitations of Claim 14 as contained in the ~~Application as originally filed.~~ Since the Application as originally filed contains the claims originally filed, it is respectfully submitted that it is appropriate to amend the Specification to contain the limitations of the claims as filed.

Likewise, in view of the typographical error previously made, this has also been corrected with respect to the amendment made to the Specification.

Rejection

Claims 2-9 and 15-18 had been rejected as being unpatentable over a combination of Fukui, PS '266 and Oya. The Examiner has taken the position that it would be obvious to one of skill in the art to replace the reducing agent of formula (1) of Fukui with formula (I) of PS '266.

It has been Applicants' position that such a combination is not obvious in light of the surprising and unexpected results that are obtained by the combination of a compound of formula (1) of the present Invention and formula (3) of the present Invention. In the previous Office Action, the Examiner had criticized our previously submitted Declaration because only one compound that fell within formula (1) of the present Invention was tested. In order to address this fact, additional tests have been done and are presented herein by way of the Declaration of Mr. Fukusaka.

It will be noted that Mr. Fukusaka's Declaration is unexecuted, however, the data contained therein originated with the Declarant and is, therefore, entirely reliable. The Declaration has been sent to Mr. Fukusaka for execution and, as soon as the completed document is received, it will be forwarded to the Examiner. In the meantime, it is respectfully requested that the Examiner consider the data in the Declaration in his evaluation of patentability.

As demonstrated in the Declaration and specifically in Table 6, seven different compounds that fall within formula (1) of the present Invention were tested. The chemical representations of these formulas are shown on pages 14-19 in the Application. A review of these formulas show that a wide variety of chemical compounds that fall within formula (1) were tested.

It is also evident from Table 7 of the Declaration, that
~~all of these compounds that fall within Formula (1) of the~~
present Invention provided superior results. Respectfully, Applicants have demonstrated that the superior results that are obtained with the present Invention carry through for all the

different chemical compositions that fall within formula (1) of the present Invention. Furthermore, the Examiner's attention is directed to Table 1 on page 123 of the Application. In that Table, data for an additional six chemical compounds that fall within formula (1) are illustrated, namely, 1-9, 1-44, 1-45, 1-48, 1-52 and 1-64. The results from these tests are reported in Table 2 on page 128 of the Application. Respectfully, Applicants have provided data for fourteen different chemical compositions that fall within formula (1). This data evidences the fact that fourteen different chemical compounds that fall within formula (1) function in accordance with the present Invention. It is submitted that the data, as contained in the attached Declaration and presented in the Application, clearly demonstrate that the group of compounds falling within the scope of formula (1) of the present Invention provides similar results. It is also submitted that the number of tests that are presented herein clearly support Applicants' assertions concerning the present Invention.

~~It will be noted that Claim 15, the independent claim as~~
recited herein, has been amended to specify the type of
aliphatic carboxylic acid that is used to make the silver salt.
It is specified to having 10 to 30 carbon atoms.

It will also be noted that Claim 15, the independent claim herein, has been amended to recite the specific molar ratio between the compound of formula (1) and the compound of formula (3).

Moreover, Applicants have better defined the subject matter of the present Invention and the test results that are shown in the Declaration have demonstrated that their material produces surprising and unexpected results compared to the prior art thereby resulting in the patentability of the present Invention.

Respectfully, based on the data presented herein, and the amendments made herein, the claims are patentable over each of the references taken alone or in combination since Applicants have clearly demonstrated the surprising and unexpected results which are obtained with the present Invention.

Conclusion

~~In view of the foregoing and the enclosed, it is~~
respectfully submitted that the Application is in condition for allowance and such action is respectfully requested. Should any further fees or extensions of time be necessary in order to

maintain this Application in pending condition, appropriate requests are hereby made and authorization is given to debit Account # 02-2275.

Respectfully submitted,

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Encl: Unexecuted Declaration of Mr. Fukusaka

DCL/mr